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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,490	07/09/2001	Hidetada Fukushima	010866	4191

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EXAMINER

SALAD, ABDULLAHI ELMI

ART UNIT PAPER NUMBER

2157

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/900,490	<b>Applicant(s)</b> FUKUSHIMA ET AL.	
	<b>Examiner</b> Salad E. Abdullahi	<b>Art Unit</b> 2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 8-11 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-11 and 13-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**Response to Amendment**

1. The amendment filed on 9/29/2005 has been received and made of record.
2. Applicant's argument with respect claims 8-11 and 13-16 have been fully considered but are moot in view of new grounds of rejection.
3. The office action examiner has indicated claims 8-11 and 13-16. However, upon further consideration of the claims, a new ground(s) of rejection is made. Examiner apologizes for any burden bears to the applicant.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 8, 11 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted step(s): The claims recite: "determination means that determines whether a maintenance actual result value is larger than a maintenance prediction value". Thus leaving the claims with no practical result.
6. Regarding claim 8, the word "means" is preceded by the word(s) "an input in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

7. Regarding claim 8, the word "means" is preceded by the word(s) "a determination in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

8. Claim 13 recites the limitation "the means " in line 8. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 14 recites the limitation "the maintenance value " in line 1. There is insufficient antecedent basis for this limitation in the claim.

10. Claim 14 recites the limitation "the dividend " in line 2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claim 13 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Because any of the steps of the method claim

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does not require the use of hardware to accomplish the step, thus making the claim as not being tangible or being an abstract idea.

### DETAILED ACTION

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 8-11 and 13-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Gonya. U.S. Patent Application Publication No. 20010032109[hereinafter Gonya].

As per claim 8 and 13 discloses a management system of a machine, comprises:

a maintenance rank table organized by model that stores a maintenance prediction value with respect to a maintenance within a contract term or a contract time for two or more contract ranks every each model (see fig. 2 and paragraph 0019 and 0029) an input means that enters a model of machine that makes a maintenance contract, a contract rank, (see paragraph 0021) and a maintenance actual result value (see fig. 1 and paragraph 0013 and 0026);

a means for storing a maintenance actual result value, where the maintenance actual result value of the machine, which is entered using the input means and accumulatively stored, and a determination means that determines whether a maintenance actual result value is larger than a maintenance prediction value(see fig. 2 and paragraph 0019 and 0024 and 0027), where the maintenance prediction value that corresponds to the

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machine's mode and the contract rank is read out of the maintenance rank table organized by model after a expiration of the contract of the machine, while the maintenance result value of the machine is read out of the storage means that stores the maintenance actual result value (see paragraph 0027).

As per claim 11, the claim includes features discussed above with respect to claim 8, further reciting the management system of a machine, comprising:  
a client terminal (see fig. 1 element 10) and a server (see fig. 1, element 15) that connects to the client terminal through a network, wherein the client server includes an input means for entering a model of machine under a maintenance contract, a contract rank, a maintenance actual result value, a display means, and a control means that requests data to the server and represents the data transmitted from the server on the display means (see fig. 1 and paragraph 0013).

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 9-10 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gonya.

As per claims 9-10 and 14-16 Gonya discloses substantial features of the claimed as discussed above with respect claims 8 and 13,

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Gonya does not explicitly disclose calculating dividend, where a dividend is calculated if under the condition that the maintenance actual value is lower than the maintenance predicted value and the difference between these values is higher than the predetermined value.

However, "Official Notice" is taken that both the concept and advantage of Calculating dividend is well known in the art. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to calculate dividend values such that any surplus value determined can be divided and distributed to the appropriate entity

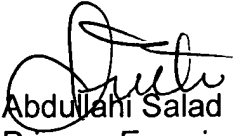
### ***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Salad E Abdullahi whose telephone number is 571-272-4009. The examiner can normally be reached on 8:30 - 5:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**

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18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Abdullahi Salad  
Primary Examiner  
10/27/2005